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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 11/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/401,939</b>	Applicant(s) <b>Michael C. SCROGGIE et al.</b>
Examiner <b>Stephen M. Gravini</b>	Art Unit <b>3622</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on 10-23-02

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 32-70 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 32-70 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 10 11

6)  Other:

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## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. Examiner objects to the tremendous volume of references. More than one month after the first Office action on the merits in the present application (which included a prior art search), applicants have submitted more than 300 references which confuses the issue of patentability over the prior art. Examiner considers relevant information as to the patentability of the claimed invention may be buried under the thousands of pages of prior art references submitted by the applicants well after a prior search was conducted by the Office. Applicants have not offered assistance to the Office by explaining the patentability of the claimed invention in light of the tremendous volume of references. It is requested that the applicant highlight the most relevant references for the Office per MPEP 2004.

### ***Requirements for Information***

2. 37 CFR 1.105 states: (a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

- (I) Commercial databases : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
- (ii) Search : Whether a search of the prior art was made, and if so, what was searched.

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- (iii) Related information : A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
- (iv) Information used to draft application : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.
- (v) Information used in invention process : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.
- (vi) Improvements : Where the claimed invention is an improvement, identification of what is being improved.
- (vii) In Use : Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(I), (iii), and (vii) of this section may also be applied to such assignee.

(3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

3. Examiner requires copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result and identification of what is being improved. Patents or printed publication information submission is required particularly for the claimed subject matter relating to the claimed features beginning with the recitations “transmitting selection data,” “generating token data,” “identifying token data,” and “generating a purchase incentive.”

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***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 32-70 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention and in the alternative, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The independently claimed steps of transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network and generating token data depending on selection data are not enabled by the specification, because the specification does not discuss transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network and generating token data depending on selection data. Since the specification does not discuss these critical independently claimed elements in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claimed features are not enabled by the specification because examiner considers them to be

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concepts that cannot be practically applied to any embodiment of the invention such that those skilled in the art could make or use the invention. The specification merely recites vague language used in the claims and does not teach elements that one skilled in the art would need to make or use the invention. Since claims 33-44, 46-57, and 59-70 depend upon claim 32, 45, and 58 which recite the independently claimed non-enabling feature, those claims are also rejected as being non-enabling from the independent parent claim. In order to consider those claims in light of the prior art, examiner will assume that those claims contain enabling subject matter.

6. Claims 32-70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed steps of transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network and generating token data depending on selection data fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because the specification does not provide an antecedent basis of transmitting selected data or generating token data. Since the specification does not provide an antecedent basis for these critical independently claimed steps, the independently claimed invention is not described in the specification such that it fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Since claims 33-44, 46-57, and 59-70 depend upon claim 32, 45, and 58 which recite the independently claimed indefinite feature, those claims are

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also rejected as being indefinite from the independent parent claim. In order to consider those claims in light of the prior art, examiner will assume that those claims contain non-indefinite subject matter.

***Claim Rejections - 35 USC § 102***

7. Claims 32-70 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by von Kohorn (US 5,128,752), Ferguson et al. (US 5,256,863), Deaton et al. (US 5,430,644), or Day et al. (US 5,857,175).

***Claim Rejections - 35 USC § 103***

8. Claims 32-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike.com (hereinafter PerformanceBike). Since at least 1994, PerformanceBike has performed the claimed method, system, and program of:

transmitting promotion data identifying a plurality of product discounts from a main personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

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transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items. Examiner also has personal knowledge of instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification. The claimed promotion data transmission and product discount display occur when the examiner went into a PerformanceBike retail outlet store and viewed discounted products from a sales catalog. The selection data transmission occurs when the examiner uses the red courtesy phone (functionally equivalent to a claimed personal computer) and calls the retail outlet distribution center (functionally equivalent to the claimed main computer). The generating, transmitting, and identifying token data occurs

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when examiner's frequent buyer card bar code number is processed for the product selection data made from the red courtesy phone (examiner's frequent buyer card bar code number is the same as the claimed token data). The step of determining discount items being purchased occurs when the retail outlet distribution center verifies the final purchase order of the examiner. Generating purchase incentive based on discount items occurs when the examiner is credited with frequent buyer points rewarded for discount item purchased. The dependently claimed steps including instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification are also services and features available using PerformanceBike based on examiner's experience. The claimed invention, recited by the applicant, has been provided by PerformanceBike long before the filing of applicants' invention. Examiner takes Official notice that it is old and well known to those skilled in the art of distributing purchase incentives to consumers, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of the published prior art. Furthermore examiner experience teaches the claimed invention except for the personal computer display. It would have been obvious to one skilled in the art to provide a personal computer display since the computer display is merely an automated feature of a concept that is old and well known as discussed above. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ

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193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art). The motivation to combine applicants claimed invention with the services offered by PerformanceBike in order is to allow advertisers greater consumer targeting capabilities, while transferring information, which clearly shows the obviousness of the claimed invention.

***Double Patenting***

9. Claims 32-70 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,970,469 or claims 1-10 of U.S. Patent No. 6,185,541. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claim of encoded data ('469 patent) is an obvious variation of the application claimed token data and the patent claimed advisory message ('541 patent) is an obvious variation of the application claimed general purchase incentive because both perform the same function in the same manner with the same result.

10. Claims 32-70 are rejected under 35 U.S.C. 103(a) as being obvious over copending Application Nos. 09/478,351 or 09/567,274 or 09/716,404. Each application contains claims reciting obvious variation to the claimed method, system, and program of:

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transmitting promotion data identifying a plurality of product discounts from a main personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items along with instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification.

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The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

*Response to Arguments*

11. Applicant's arguments filed October 23, 2002 have been fully considered but they are not persuasive.

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*enablement, new matter, indefiniteness rejections*

Applicants argue that the specification page 9 lines 4-9 overcomes the non-enabling and alternatively new matter feature of transmitting selection data because it clearly discloses a consumer selecting coupon offers out of a plurality of offers. That portion of the specification merely discusses a consumer offer display from a manufacturer and accumulation thereof and is silent with respect to the claimed “discount selected from a personal computer to a main computer over a computer network.” Nothing in applicants response or specification addresses this claimed feature expressly or implicitly and additionally shows that the claimed feature is new matter reinforcing the enablement rejection.

Applicants also argue that the specification page 24 lines 2-6 overcomes the non-enabling feature of generating toke data depending on selection data because a server transmits token images defining coupon offerings to the user. The recited “depending on said selection data” in that claimed feature is not discussed implicitly or expressly in the cited or any part of the specification. Applicants have not addressed the nexus of the claimed token data generation dependent upon selection data.

Applicants comment regarding the specification and claim language is noted and the rejection has been modified to more accurately address the enablement features. However the cited specification does not provide enablement for the claimed features discussed supra.

Applicants are correct in the rejection of claims 32-70 instead of examiner’s typographical error in stating claims 1-20 and that error has been remedied. However examiner must look to

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the specification in interpreting the claims, and since the claims fail to particularly point out and distinctly claim the subject matter of the invention, it is proper to reject those claims based on an improper antecedent basis from the specification. Please see MPEP 608.01(g) and 37 CFR 1.75(d)(1) since the scope of the claims is indeterminate.

*anticipatory rejections*

Examiner has withdrawn the prior art rejections based on applicants arguments that the references are not prior art but relies only the portion of the claims supported by the priority documents which can be properly rejected. Examiner will assume that the claims recite subject matter found in the priority documents but since the claims in the present application contain subject matter not supported by the specification, those enablement and indefiniteness rejections will be maintained.

Applicants argue that the claimed invention is not anticipated by any of the prior art used in the rejection above. The claimed invention is understood to be a method and system of transmitting promotion and selection data for personal computer display while generating, transmitting, and identifying token data in a retail store for discounted purchase from a main computer. In other words the invention as claimed communicates two different types of data between a main and personal computer with one of the types of data used to provide a basis for a third type of data.

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Applicants argue that Day does not disclose the non enabling and indefinite features rejected above along with the claimed token data (one of two types of data) being transmitted back to the main from personal computers and retail store identification for generating a purchase incentive or third type of data. Applicants also argue that von Kohorn does not disclose an online distribution of data claimed as purchase incentives or a two-way interactive user retailer system. Applicants further argue that Deaton does not disclose the distribution of coupons or similar incentives. Applicants finally argue that Ferguson does not disclose generation of a third type of data or take data dependent upon one of two types of data or selection data. In response to applicants arguments, the invention as claimed is merely a method and system which communicates two different types of data between a main and personal computer with one of the types of data used to provide a basis for a third type of data. Each of the clearly anticipated references disclose the claimed invention on the face of each reference and examiner maintains the rejection based on applicants claimed invention and supporting arguments.

*obviousness rejections*

Examiner has appended this Office action with a declaration supporting the obviousness rejection. Examiner notes that web site argued is not claimed and that the claimed main and personal computers satisfy the in store red courtesy phone ordering to the retail merchandiser.

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*double patenting rejection*

Both patents supporting the double patenting rejections are obvious variations of the claimed invention as discussed supra under that rejection. Applicants assert patentability over those patents without patentably distinguishing the independent and distinct features. Both patents encompass the subject matter claimed in the present invention and therefore examiner maintains the double patenting rejection.

Applicants further assert the provisional double patenting rejection is improper because those applications do not qualify as prior art. However, both applications claim priority such that each may qualify as prior art.

*Conclusion*

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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13. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

<b>After-final</b>	<b>(703) 872-9327</b>
<b>Official</b>	<b>(703) 872-9326</b>
<b>Non-Official/Draft</b>	<b>(703) 872-9325</b>

*Steve Gravini*  
**STEPHEN GRAVINI**  
**PRIMARY EXAMINER**

smg

November 21, 2002

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**EXAMINER AFFIDAVIT SUPPORTING OBVIOUSNESS REJECTION**

Claims 32-70 are an obvious variation over examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike.com (hereinafter PerformanceBike). Since at least 1994, PerformanceBike has performed the claimed method, system, and program of:

transmitting promotion data identifying a plurality of product discounts from a main personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

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generating a purchase incentive based on said discount items. Examiner also has personal knowledge of instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification. The claimed promotion data transmission and product discount display occur when the examiner went into a PerformanceBike retail outlet store and viewed discounted products from a sales catalog. The selection data transmission occurs when the examiner uses the red courtesy phone (functionally equivalent to a claimed personal computer) and calls the retail outlet distribution center (functionally equivalent to the claimed main computer). The generating, transmitting, and identifying token data occurs when examiner's frequent buyer card bar code number is processed for the product selection data made from the red courtesy phone (examiner's frequent buyer card bar code number is the same as the claimed token data). The step of determining discount items being purchased occurs when the retail outlet distribution center verifies the final purchase order of the examiner. Generating purchase incentive based on discount items occurs when the examiner is credited with frequent buyer points rewarded for discount item purchased. The dependently claimed steps including instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification are also services and features available using

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PerformanceBike based on examiner's experience. The claimed invention, recited by the applicant, has been provided by PerformanceBike long before the filing of applicants' invention. Examiner takes Official notice that it is old and well known to those skilled in the art of distributing purchase incentives to consumers, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of the published prior art. Furthermore examiner experience teaches the claimed invention except for the personal computer display. It would have been obvious to one skilled in the art to provide a personal computer display since the computer display is merely an automated feature of a concept that is old and well known as discussed above. The motivation to combine applicants claimed invention with the services offered by PerformanceBike is to allow advertisers greater consumer targeting capabilities, while transferring information, which clearly shows the obviousness of the claimed invention.

I hereby declare that all statements made under this declaration of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under 18 USC 1001 and that such will false statements may jeopardize the validity of the application or any patent issued thereon.

*Steve Ghariv*